

ESTTA Tracking number: **ESTTA114906**

Filing date: **12/15/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Esurance, Inc.
Granted to Date of previous extension	12/16/2006
Address	747 Front Street San Fransisco, CA 94111 UNITED STATES
Correspondence information	Mary R. True Frost Brown Todd LLC 2200 PNC Center, 201 East Fifth Street Cincinnati, OH 45202 UNITED STATES mtrue@fbtlaw.com Phone:(513) 651-6143

Applicant Information

Application No	78754127	Publication date	10/17/2006
Opposition Filing Date	12/15/2006	Opposition Period Ends	12/16/2006
Applicant	Cohen, Douglas A. 500 N. State College Blvd, Suite 550 Orange, CA 92868 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 1998/10/00 First Use In Commerce: 1998/10/00

All goods and sevicees in the class are opposed, namely: Quoting, underwriting, and writing of insurance, namely property and casualty, life, heath, liability, commercial, title, surplus, fidelity, marine fire, surety, disability, plate glass, worker's compensation, common carrier liability, broiler and machinery, burglary, credit, sprinkler, team and vehicle, mortgage, aircraft, mortgage guaranty, legal insurance, financial guarantee; claims administration, claims adjustment, brokerage, financial planning, consultation and research in the fields of insurance and financial planning

Attachments	Email_fr6-not-opp.pdf (6 pages)(249214 bytes)
Signature	/mrt/
Name	Mary R. True
Date	12/15/2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF: TRADEMARK APPLICATION NO. 78/754,127 – E
ENSURANCE.COM

DATE OF PUBLICATION: October 17, 2006

ESURANCE, INC.

Opposer,

v.

DOUGLAS A. COHEN

Applicant.

Notice of Opposition _____

NOTICE OF OPPOSITION

Esurance Inc., a Delaware corporation with its principal place of business at 650 Davis Street, San Francisco, California 94111 (“Opposer”), believes that it is and will be damaged by registration of application Serial No. 78/754,127 – E ENSURANCE.COM, for “Quoting, underwriting, and writing of insurance, namely property and casualty, life, health, liability, commercial, title, surplus, fidelity, marine fire, surety, disability, plate glass, worker’s compensation, common carrier liability, broiler and machinery, burglary, credit, sprinkler, team and vehicle, mortgage, aircraft, mortgage guaranty, legal insurance, financial guarantee; claims administration, claims adjustment, brokerage, financial planning, consultation and research in the fields of insurance and financial planning,” in Class 36, filed by Douglas A. Cohen, and hereby opposes the same under the provisions of *Section 13 of the Trademark Act of July 5, 1946, 15 U.S.C. § 1063*. As grounds therefor, it is alleged that:

1. Opposer has, since prior to October 1998, the claimed first use date of Douglas A. Cohen (hereinafter referred to as “Applicant”) for the trademark E ENSURANCE.COM, for “Quoting, underwriting, and writing of insurance, namely property and casualty, life, health, liability, commercial, title, surplus, fidelity, marine fire, surety, disability, plate glass, worker’s

compensation, common carrier liability, broiler and machinery, burglary, credit, sprinkler, team and vehicle, mortgage, aircraft, mortgage guaranty, legal insurance, financial guarantee; claims administration, claims adjustment, brokerage, financial planning, consultation and research in the fields of insurance and financial planning", been engaged in the offering of a wide variety of insurance services, including automobile, property, life and health insurance, and in providing claims administration and adjustment services.

2. Opposer has engaged in the business of providing numerous types of insurance products and services throughout the United States, primarily via the Internet, under the mark ESURANCE since at least April of 1998.

3. Opposer is the owner of, among others, the following federally registered trademark and service mark for use in connection with insurance services:

ESURANCE- Registration No. 2,708,357, registered April 22, 2003 for quoting, underwriting and writing of insurance, namely, property and casualty, providing services, namely, claims administration, claims adjustment, brokerage, insurance policy management, financial planning, consultation and research in the fields of insurance and financial planning.

Copies of the certificate of registration for the ESURANCE trademark is attached to this Notice of Opposition as Exhibit 1. As soon as certified copies of the Exhibit is received from the U.S. Patent and Trademark Office, they will be submitted with an Amended Notice of Opposition.

4. The certificate of registration identified in paragraph 3 is valid and subsisting and record title is in Opposer; the certificate of registration is *prima facie* evidence of the validity of the registration, the Registrant's ownership of the mark, and of the Registrant's exclusive right to use the mark in commerce in connection with the goods and services specified in the certificate of registration under the provisions of 15 U.S.C. § 1057(b) and constructive notice of the Registrant's claim of ownership under 15 U.S.C. § 1072.

6. On November 15, 2005, Applicant filed application Serial Number 78/754,127 – E ENSURANCE.COM, for "Quoting, underwriting, and writing of insurance, namely property and casualty, life, health, liability, commercial, title, surplus, fidelity, marine fire, surety, disability, plate glass, worker's compensation, common carrier liability, broiler and machinery, burglary, credit, sprinkler, team and vehicle, mortgage, aircraft, mortgage guaranty, legal

insurance, financial guarantee; claims administration, claims adjustment, brokerage, financial planning, consultation and research in the fields of insurance and financial planning".

7. The Applicant's services offered under E ENSURANCE.COM, for "Quoting, underwriting, and writing of insurance, namely property and casualty, life, health, liability, commercial, title, surplus, fidelity, marine fire, surety, disability, plate glass, worker's compensation, common carrier liability, broiler and machinery, burglary, credit, sprinkler, team and vehicle, mortgage, aircraft, mortgage guaranty, legal insurance, financial guarantee; claims administration, claims adjustment, brokerage, financial planning, consultation and research in the fields of insurance and financial planning" are virtually identical services to those offered by Opposer under its ESURANCE mark.

8. Upon information and belief, the services for which Applicant seeks to register the designation E ENSURANCE.COM involve offering the same services under the same mark to the same persons, namely consumers seeking insurance products and services, as those of the Applicant.

9. Upon information and belief, the Applicant's services will be marketed, promoted and offered through the same marketing channels as are the services provided by Opposer under its ESURANCE mark.

10. The designation E ENSURANCE.COM which the Applicant seeks to register is nearly identical to the Opposer's ESURANCE trademark. The dominant portion of the term Applicant seeks to register is "Esurance" and Applicant has inserted only the letter "N" to Opposer's ESURANCE mark. The additions of the prefix "E" and the ".COM" suffix are irrelevant and do not serve to distinguish Applicant's E ENSURANCE.COM designation from Opposer's ESURANCE mark.

11. The Opposer, since prior to the adoption and use of E ENSURANCE.COM by the Applicant, has spent, and continues to spend, large sums of money in the promotion and advertisement of its insurance products and services identified and distinguished by its ESURANCE trademarks, and by reason of such promotion and advertising and the high quality of its products and services carrying the Opposer's trademarks, Opposer now enjoys a valuable goodwill and an enviable reputation with respect to its trademarks and its goods and services, including on-line sales and quoting of insurance products and services.

12. The distinctive trademark ESURANCE has attained widespread public recognition and acquired great value as an identification of the source of goods and services in or by Opposer, and the said mark distinguishes Opposer's goods and services from the goods and services of others.

13. The designation E ENSURANCE.COM which Applicant seeks to register consists of only a slight variation of Opposer's entire ESURANCE mark. The addition of the prefix "E" and the suffix ".COM" to indicate that Applicant's services are available via the Internet does not differentiate Applicant's mark from Opposer's and reduce the likelihood of confusion; rather it increases the likelihood of confusion among consumers seeking insurance products and services via the Internet who are familiar with the products and services Opposer offers under its ESURANCE mark, and such persons will believe that they are dealing with Opposer.

14. The use, promotion and registration of E ENSURANCE.COM by the Applicant will cause consumers and potential purchasers of insurance products and services throughout the United States to assume, erroneously, and to be confused, misled and/or deceived, that the Applicant's E ENSURANCE.COM products and services are affiliated with, endorsed or sponsored by Opposer, all to the Opposer's irreparable damage.

15. For the reasons set forth in paragraph 1 through 14, Opposer believes, and believing asserts, that the goodwill in its ESURANCE trademark for insurance products and services will be damaged under Section 2(d), and that the Applicant should be denied the registration of the term E ENSURANCE.COM for all of the services for which it has made application.

16. By reason of the foregoing, Applicant's application of E ENSURANCE.COM for insurance products and services is likely to cause confusion with Opposer's marks for the same and related insurance services and is thus not registrable under Section 13 of the Trademark Act of 1946 (15 U.S.C. § 1063).

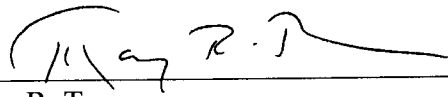
WHEREFORE, Opposer prays that this Opposition be sustained and that application Serial No. 78/754,127 - E-ENSURANCE.COM - be refused registration.

The fee of \$300.00 as provided by *Sections 13 and 31 of the Trademark Act of 1946* is paid by charging Opposer's attorneys' deposit account.

Please recognize Mary R. True, Joseph R. Dreitler, Brian J. Downey and Nicolette R. Hudson, all members of the Bar of the State of Ohio, as its attorneys to prosecute this Notice of Opposition and to transact all business in the Patent and Trademark Office in connection herewith. Please address all communications to: Mary R. True, c/o Frost Brown Todd LLC, 2200 PNC Center, Suite 2300, Cincinnati, Ohio 45202.

Dated: December 15, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mary R. True', is written over a horizontal line.

Mary R. True
Joseph R. Dreitler
Brian J. Downey
Nicolette R. Hudson
FROST BROWN TODD LLC
2200 PNC Center, Suite 2300
Cincinnati, OH 45202
Telephone: (513) 651.6143
Facsimile: (513) 651-6981

Attorneys for Opposer
Esurance Inc.

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,708,357

United States Patent and Trademark Office

Registered Apr. 22, 2003

**SERVICE MARK
PRINCIPAL REGISTER**

ESURANCE

ESURANCE INC. (DELAWARE CORPORATION)
2800 THIRD STREET, 2ND FLOOR
SAN FRANCISCO, CA 94107

CONSULTATION AND RESEARCH IN THE FIELDS
OF INSURANCE AND FINANCIAL PLANNING, IN
CLASS 36 (U.S. CLS. 100, 101 AND 102).

FOR: QUOTING, UNDERWRITING, AND WRIT-
ING OF INSURANCE, NAMELY, PROPERTY AND
CASUALTY, PROVIDING SERVICES, NAMELY,
CLAIMS ADMINISTRATION, CLAIMS ADJUST-
MENT, BROKERAGE, INSURANCE POLICY MAN-
AGEMENT, FINANCIAL PLANNING,

FIRST USE 4-22-1998; IN COMMERCE 4-22-1998.

SER. NO. 76-084,974, FILED 7-7-2000.

DEZMONA MIZELLE, EXAMINING ATTORNEY